



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

jm

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,419	12/01/2000	Marilyn J. Marshall	99 - 1930	4408

7590

07/01/2002

Attn: Ivar M. Kaardal
Kaardal & Associates, pc
3500 South First Ave. Circle - Suite 250
Sioux Falls, SD 57105-5802

EXAMINER

LEE, Y MY QUACH

ART UNIT

PAPER NUMBER

2875

DATE MAILED: 07/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/727,419

Applicant(s)

MARILYN MARSHALL

Examiner

Y QUACH LEE

Group Art Unit

2875

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 4/1/2002
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1 and 4 to 18 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 10 is/are allowed.
- ☒ Claim(s) 1, 11, 12 and 18 is/are rejected.
- ☒ Claim(s) 4 to 9 and 13 to 17 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 2875

DETAILED ACTION***Response to Arguments***

1. Applicant's arguments filed April 1, 2002 have been fully considered but they are not persuasive. In response to the arguments on pages 2 to 4 regarding claims 1, 11, 12 and 18, it should be noted that Applicant has not discussed how the claims avoid the references or distinguish from them. An allegation that the Examiner has used the benefits achieved by the applicant's claimed structure ... benefits described in applicant's disclosure in hindsight as the motivation for combining the references without specifically pointing out how the language of the claims patentably distinguishes them from the references or without clearly pointing out the patentable novelty which the Applicant thinks the claims present in view of the state of the art disclosed by the references cited is not persuasive. Also, in response to applicant's argument that there is no suggestion to combine in the references, it should be noted that it is not necessary that the motivation to make the modification be expressly suggested, articulated or in so many words, the changes or improvements that applicant has made. The test for combining references is what the combination of disclosures taken as a whole would have suggested to one of ordinary skill in the art. Further, in response to Applicant's argument that the Examiner's conclusion of obviousness is based upon hindsight reasoning, it should be noted that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Furthermore, in response to applicant's argument that the need to combine a multiplicity of references in an attempt to meet the claimed invention is evidence of nonobviousness, it should be noted that reliance on a multiplicity of references in a rejection does not weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). Accordingly, the combination of references cited against the claims as shown in paragraphs 3 to 5 of the Office Action of December 31, 2001 is proper and therefore repeats as follows.

Claim Rejections - 35 USC § 103

Art Unit: 2875

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Steinhart (prior art previously cited) in view of Kidder et al. (prior art previously cited), Benjafield (prior art previously cited), and Ryan (prior art previously cited).

Steinhart discloses a handbag assembly comprising a bag (10) having walls, a main compartment (41) having an opening into the main compartment, a side compartment (55), a cover member (56) removably closing over the side compartment, a fastening member such as a zipper (column 5, line 21) securely attached about a portion of a perimeter of the side compartment and along a portion of a perimeter of the cover member for holding the cover member in a closed condition over the side compartment, a carrying strap (19) having ends attached to the bag, a fastener (16, 17) for closing the opening into the main compartment, a plurality of pockets (20, 32, 60) attached to the bag, and a coin pouch (39) attached to the bag in side compartment. However, Steinhart does not disclose a light emitting means removably attached to the bag, a mirror attached to the cover member, and a hook assembly attached to one of the walls of the bag in the main compartment.

Kidder et al. teach that it is known in the art to include light emitting means (10) removably attached to the bag so that the light emitting means can illuminate the interior of the bag during darkness and can be used from one bag to another bag.

Benjafield teaches a mirror (9) securely attached to a cover member (7) to allow the user to gaze into the mirror when necessary.

Ryan teaches a hook assembly (1, figure 1) securely attached to one of the walls of the bag for holding keys and other object which would inherently include mace.

It would have been obvious to one skilled in the art to provide Steinhart with light emitting means removably attached to the bag, as shown by Kidder et al., for not only illuminating the interior of the bag but also using from one bag to the other bag. It would have also been obvious to one skilled in the art to provide the cover member of Steinhart with a

Art Unit: 2875

mirror, as shown by Benjafield, for allowing the user to gaze when necessary. It would have been obvious to one skilled in the art to provide Steinhart with a hook assembly, as shown by Ryan, for holding keys and other objects. Note that closing the coin pouch with a zipper, as opposed to other fastening means, would have been an obvious matter of design choice which provides no unusual, unobvious, and/or unexpected result and is therefore deemed to fall within a purview of an ordinary engineering designed technique to provide any fastening means as long as it closes the coin pouch.

4. Claims 11 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steinhart (prior art previously cited) in view of Kidder et al. (prior art previously cited), Benjafield (prior art previously cited), and Ryan (prior art previously cited).

Steinhart discloses a handbag assembly comprising a bag (10) having walls forming a main compartment (41), the main compartment having an opening, a side compartment (55) having a cover member (56) pivotally mounted on the walls, a fastening member such as a zipper (column 5, line 21) releasably fastening a portion of a perimeter of the cover member to a portion of a perimeter of the side compartment, a carrying strap (19) having ends attached to the bag, a fastener (16, 17) for closing the opening into the main compartment, a plurality of pockets (20, 32, 60) attached to the bag, and a coin pouch (39) attached to the bag in side compartment. However, Steinhart does not disclose a light emitting means removably attached to the bag, a mirror attached to the cover member, and a hook assembly attached to one of the walls of the bag in the main compartment.

Kidder et al. teach that it is known in the art to include light emitting means (10) removably attached to the bag so that the light emitting means can illuminate the interior of the bag during darkness and can be used from one bag to another bag.

Benjafield teaches a mirror (9) securely attached to a cover member (7) to allow the user to gaze into the mirror when necessary.

Ryan teaches a hook assembly (1, figure 1) securely attached to one of the walls of the bag for holding keys.

It would have been obvious to one skilled in the art to provide Steinhart with light emitting means removably attached to the bag, as shown by Kidder et al., for not only

Art Unit: 2875

illuminating the interior of the bag but also using from one bag to the other bag. It would have also been obvious to one skilled in the art to provide the cover member of Steinhart with a mirror, as shown by Benjafield, for allowing the user to gaze when necessary. It would have been obvious to one skilled in the art to provide Steinhart with a hook assembly, as shown by Ryan, for holding keys.

5. Claims 11, 12 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strong (prior art previously cited) in view of Hill (prior art previously cited), Benjafield (prior art previously cited), Steinhart (prior art previously cited) and Ryan (prior art previously cited).

Strong discloses a handbag assembly comprising a bag (10, 110) having walls forming a main compartment (12, 112), the main compartment having an opening (24, 124), a side compartment (30, 130) having a cover member (32, 132) pivotally mounted on the walls, a fastening member such as a zipper (38, 40, 42, 138, 140, 142) releasably fastening a portion of a perimeter of the cover member to a portion of a perimeter of the side compartment, a carrying strap (figure 3) having ends attached to the bag, and a fastener (126) or such as a draw string (26) for closing the opening into the main compartment. However, Strong does not disclose a plurality of pockets attached to the bag, a light emitting means removably attached to the bag, a mirror attached to the cover member, a coin pouch attached to the bag in side compartment, and a hook assembly attached to one of the walls of the bag in the main compartment.

Hill teaches that it is known in the art to secure a plurality of pockets (figure 1) to the bag to organize and store different items in the bag and to include a light emitting means (10) removably attached to the bag so that the light emitting means can illuminate the interior of the bag during darkness and can be used from one bag to another bag.

Benjafield teaches a mirror (9) securely attached to a cover member (7) to allow the user to gaze into the mirror when necessary.

Steinhart teaches a coin pouch (39) attached to the bag in side compartment for holding coinages

Ryan teaches a hook assembly (1, figure 1) securely attached to one of the walls of the bag for holding keys.

Art Unit: 2875

It would have been obvious to one skilled in the art to provide Strong with a plurality of pockets and light emitting means removably attached to the bag, as shown by Hill, for not only storing and organizing different items within the bag but also for illuminating the interior of the bag from one bag to the other bag. It would have also been obvious to one skilled in the art to provide the cover member of Strong with a mirror, as shown by Benjafield, for allowing the user to gaze when necessary. It would have further been obvious to one skilled in the art to provide Strong with a coin pouch, as shown by Steinhart, for holding coinages. It would have been obvious to one skilled in the art to provide Strong with a hook assembly, as shown by Ryan, for holding keys.

6. Claims 4 to 9 and 13 to 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claim 10 is allowable over the prior art of record.

Conclusion


8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Y Quach Lee whose telephone number is 703-308-1939. The examiner can normally be reached on Tuesday and Thursday from 8:30 am to 4:30 pm.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Y. Q.
June 27, 2002


Y Quach Lee
Patent Examiner
Art Unit 2875